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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,975	12/11/2000	Thomas Moran	476-1962	4647

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EXAMINER

PATEL, ASHOKKUMAR B

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,975

Applicant(s)

MORAN, THOMAS

Examiner

Ashok B. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Application Number 09/734, 975 was filed on 12/11/2000. Claims 1-19 are subject to examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Regarding claim 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter where:

Claim 17 recites software per se, failing to recite any hardware necessary to render the claim tangible. Claim 17 is a computer program per se and, is not tangibly embodied on a computer readable medium and is absent computer readability or execution.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 7, 8, 11, 12, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsumoto et al. (hereinafter Matsumoto)(US 6, 678, 720).

Referring to claim 1,

The reference teaches

A messaging system arranged to allow a user to send a pre-specified message to a destination party mail box, said messaging system comprising a communications network comprising: (i) a messaging server arranged to store one or more pre-specified messages; (col.10, lines 66 and col.11, lines 1-7). (ii) an input to the communications network arranged to receive a user input; and (Abstract) (iii) a destination party mail box; wherein when a specified user input is received at the input, one of the pre-specified messages is sent to the destination party mail box from the messaging server. (Fig. 2, element 16, col.12, lines 39-50).

Referring to claim 2,

The reference teaches a messaging system as claimed in claim 1 wherein said input comprises a terminal connected to the communications network and comprising a user interface. (Fig. 1, element 9).

Referring to claim 3,

The reference teaches a messaging system as claimed in claim 2 wherein the terminal is connected to the messaging server via a communications network node such as a private branch exchange. (Fig.1, element 9, col. 7, lines 44-47).

Referring to claim 7,

The reference teaches " In addition, messaging device 1 can communicate with message database as is in message database 3 the voice data, image data and text data." (col.7, lines 13-17) (wherein the messaging server is a multimedia messaging server.).

Referring to claim 8,

The reference teaches that the destination party mail box is located on a second messaging server. (Fig.1, elements 7,8 and elements 5 and 6 (IRC server- second messaging server)).

Referring to claim 11,

The reference teaches a method of sending a pre-specified message to a destination party mail box in a communications network, said method comprising the steps of: (i) storing said pre-specified message at a messaging server in the communications network; (col.10, lines 66 and col.11, lines 1-7). (ii) receiving an input from a user, said input indicating that the pre-specified message is to be sent to the destination party mail box; and (iii) sending the pre-specified message from the messaging server to the destination party mail box. (Abstract and Fig. 2, element 16, col.12, lines 39-50).

Referring to claim 12,

The reference teaches the input is received via a terminal. (Fig. 1, element 2).

Referring to claims 15,

The reference teaches a messaging server for sending a pre-specified message to a destination party mail box in a communications network, said messaging server comprising: (i) a store containing the pre-specified message; (col.10, lines 66 and col.11, lines 1-7). (ii) an input arranged to receive information, said information indicating that the pre-specified message is to be sent to the destination party mail box; (iii) a processor arranged to send the pre-specified message to the destination party mail box. (Abstract and Fig. 2, element 16, col.12, lines 39-50).

Referring to claim 16,

A communications network comprising a destination party mail box and a messaging server for sending a pre-specified message to the destination party mail box, said messaging server comprising: (i) a store containing the pre-specified message; (col.10, lines 66 and col.11, lines 1-7). (ii) an input arranged to receive information, said information indicating that the pre-specified message is to be sent to the destination party mail box; and (iii) a processor arranged to send the pre-specified message to the destination party mail box. (Abstract and Fig. 2, element 16, col.12, lines 39-50).

Referring to claim 17,

Claim 17 is a claim to a computer program that carries out the method steps of claim 15. Therefore, claim 17 is rejected for the reasons set forth for the claim 15.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-6, 9, 10, 13, 14, 18 and 19 are rejected under 35 U.S.C. 103(a) as being Unpatentable over Matsumoto et al. (hereinafter Matsumoto)(US 6, 678, 720) in view of Baxter Jr. (hereinafter Baxter) (US 6, 385, 305).

Referring to claim 4,

Keeping in mind the teachings of the reference Matsumoto as stated above, although the reference teaches the messaging server comprises a processor (Fig.1, element 1) sending notification to the destination with a pre-specified message, the reference explicitly fails to teach to append information received from a user to one of the pre-specified messages. The reference Baxter teaches " additional step to the method describe above might include encoding a sponsor message into the electronic message wherein the encoding a sponsor message comprises the step of appending the digital audio file with an audio sponsor message. Alternatively, the method might include encoding a text-based sponsor message into the body of the electronic message or encoding a sponsor message comprises the step of encoding one or more graphic elements into the body of the electronic message." (col.4, lines 14-23, Fig.6, elements 110, 120)). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to combine Matsumoto's messaging device's notification capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination. Thus, this systems provide a benefit of

transmitting digital audio file attachments to a preselected email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claims 5 and 6,

Keeping in mind the teachings of the reference Matsumoto as stated above, although the reference teaches the messaging server comprises a processor (Fig.1, element 1) sending notification to the destination with a pre-specified message, the reference explicitly fails to teach to append information received from a user to one of the pre-specified messages to create a combined message such that in use the messaging server is later able to separate the appended information from the combined message and wherein the processor is arranged to create the combined message such that in use, when the combined message is displayed to a user the appended information is displayed as part of the pre-specified message. The reference Baxter teaches “additional step to the method describe above might include encoding a sponsor message into the electronic message wherein the encoding a sponsor message comprises the step of appending the digital audio file with an audio sponsor message. Alternatively, the method might include encoding a text-based sponsor message into the body of the electronic message or encoding a sponsor message comprises the step of encoding one or more graphic elements into the body of the electronic message.” (col.4, lines 14-23, Fig.6, elements 110, 120). The reference also teaches “the voice mail server 30 then records the caller's audio voice message 90 onto a storage medium. The voice message is compressed and encoded into a digital audio file 40 and then attached to the email address previously identified 110. The email and digital audio file

attachment is then opened and listened to by the recipient 260. (col. 10, lines 18-23). (to append information received from a user to one of the pre-specified messages to create a combined message such that in use the messaging server is later able to separate the appended information from the combined message and wherein the processor is arranged to create the combined message such that in use, when the combined message is displayed to a user the appended information is displayed as part of the pre-specified message). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to combine Matsumoto's messaging device's notification capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to a preselected email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claim 9,

Keeping in mind the teachings of the reference Matsumoto as stated above, although the reference teaches the messaging server comprises a processor (Fig.1, element 1) sending notification to the destination with a pre-specified message, the reference explicitly fails to teach to the communications network node is arranged to route the additional information to the messaging server together with one or more control signals that are arranged to indicate that the additional information is to be appended to a pre-specified message. The reference Baxter teaches a method of transmitting one or more audio file attachments in an electronic message from a telephone including the steps of

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dialing into a predetermined telephone number, sending one or more DTMF signals on the touch-tone telephone corresponding to a preselected email address wherein the one or more DTMF signals is associated with a predetermined alphanumeric character, assembling a string of alphanumeric characters by repeating the DTMF signal entry until the preselected email address has been completed, recording an audio voice message over the touch-tone telephone, converting the audio voice message into a digital audio file, attaching the digital audio file to an electronic message directed to the preselected email address, and transmitting the electronic message to the preselected email address. (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to combine Matsumoto's messaging device's notification capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to a preselected email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claim 10,

Keeping in mind the teachings of the reference Matsumoto as stated above, although the reference teaches the messaging server comprises a processor (Fig.1, element 1) sending notification to the destination with a pre-specified message, the reference explicitly fails to teach wherein the pre-specified messages are stored in a mail box on the messaging server, said mail box being associated with the user. The reference Baxter teaches address book (Fig.6, element 240) located on server 30, which stores

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the pre-specified email addresses in the user mail box (col. 10, lines 12-18) (pre-specified messages are stored in a mail box on the messaging server, said mail box being associated with the user.) Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to combine Matsumoto's messaging device's notification capabilities with Baxter's teachings of storing pre-specified messages such that the caller has the option of retrieving it for later user and avoiding the manual entry again as taught by Baxter.

Referring to claims 13 and 14,

Keeping in mind the teachings of the reference Matsumoto as stated above, although the reference teaches the messaging server comprises a processor (Fig.1, element 1) sending notification to the destination with a pre-specified message, the reference fails to teach setting up a call between the terminal and the messaging server and receiving information from the user via this call, to be appended to the pre-specified message. and wherein the call is routed via a communications network node between the terminal and the messaging server and wherein that communications network node is arranged to send a control signal to the messaging server, indicating that the received information is to be appended to the pre-specified message. The reference Baxter teaches a method of transmitting one or more audio file attachments in an electronic message from a telephone including the steps of dialing into a predetermined telephone number, sending one or more DTMF signals on the touch-tone telephone corresponding to a preselected email address wherein the one or more DTMF signals is associated with a predetermined alphanumeric character, assembling a string of alphanumeric characters

by repeating the DTMF signal entry until the preselected email address has been completed, recording an audio voice message over the touch-tone telephone, converting the audio voice message into a digital audio file, attaching the digital audio file to an electronic message directed to the preselected email address, and transmitting the electronic message to the preselected email address. (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to combine Matsumoto's messaging device's notification capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to a preselected email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claim 18,

Keeping in mind the teachings of the reference Matsumoto as stated above, although the reference teaches the messaging server comprises a processor (Fig.1, element 1) sending notification to the destination with a pre-specified message, the reference explicitly fails to teach a communications signal arranged to be routed between a terminal and a messaging server, said communications signal comprising information and a control signal which indicates that the information is to be appended to a pre-specified message at the messaging server. The reference Baxter teaches a method of transmitting one or more audio file attachments in an electronic message from a telephone including the steps of dialing into a predetermined telephone number, sending one or more DTMF signals on the touch-tone telephone corresponding to a

preselected email address wherein the one or more DTMF signals is associated with a predetermined alphanumeric character, assembling a string of alphanumeric characters by repeating the DTMF signal entry until the preselected email address has been completed, recording an audio voice message over the touch-tone telephone, converting the audio voice message into a digital audio file, attaching the digital audio file to an electronic message directed to the preselected email address, and transmitting the electronic message to the preselected email address. (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to combine Matsumoto's messaging device's notification capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to a preselected email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claim 19,

Keeping in mind the teachings of the reference Matsumoto as stated above, although the reference teaches the messaging server comprises a processor and a communications network node arranged to be connected between a terminal and a messaging server, said communications network node comprising a processor arranged to set up a call between the terminal and the messaging server and to route information from the terminal to the messaging server using this call, (Fig.1, elements 1, 9 and 2), sending notification to the destination with a pre-specified message, the reference fails to teach wherein the processor is further arranged to send a control signal with the

routed information, said control signal indicating that the routed information is to be appended to a pre-specified message at the message server. The reference Baxter teaches a method of transmitting one or more audio file attachments in an electronic message from a telephone including the steps of dialing into a predetermined telephone number, sending one or more DTMF signals on the touch-tone telephone corresponding to a preselected email address wherein the one or more DTMF signals is associated with a predetermined alphanumeric character, assembling a string of alphanumeric characters by repeating the DTMF signal entry until the preselected email address has been completed, recording an audio voice message over the touch-tone telephone, converting the audio voice message into a digital audio file, attaching the digital audio file to an electronic message directed to the preselected email address, and transmitting the electronic message to the preselected email address. (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to combine Matsumoto's messaging device's notification capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to a preselected email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (703) 305-2655. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp



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